IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert E. Gleichauf

Serial No.:   09/751,811

Filing Date: December 29, 2000

Group Art Unit: 2131

Confirmation No.:   8466

Examiner: Aravind K. Moorthy

Title: METHOD AND SYSTEM FOR REAL-TIME INSERTION OF SERVICES DURING A CALL SESSION OVER A COMMUNICATION NETWORK

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the rejected claims in the Application.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action to establish a *prima facie* rejection of the claims. The Final Office Action rejected Independent Claims 1, 14, 29, and 36 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. 2006/0106703 A1, listing Del Rey, et al. as inventors ("*Del Rey*"). However, these rejections fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

Failure to Establish *Del Rey* Reference as Prior Art

Every rejection is based on *Del Rey*. However, *Del Rey* has an actual filing date (November 18, 2005) after the priority date of the Application (December 29, 2000). Therefore, to establish a *prima facie* rejection that utilizes *Del Rey* as a reference, the PTO must (1) establish the rejection based on the disclosure of *Del Rey*, and (2) include a showing of support in a provisional application to which *Del Rey* claims priority. *See* M.P.E.P. §706.02, Example 2 and M.P.E.P. §2136.03. The PTO has not provided such a showing. Accordingly, a *prima facie* case has not been established with *Del Rey*.

Failure of the PTO to Establish a *Prima Facie* Showing of Each and Every Feature

Notwithstanding the above, the independent claims are allowable because *Del Rey* fails to disclose each and every feature of such independent claims. As the PTO is fully aware, in order for a reference to anticipate a claim "[t]he identical invention **must** be shown in as **complete detail** as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (Emphasis Added). Further, Applicants respectfully remind the PTO that "**the particular part relied on** must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. §1.104 (Emphasis added). With these threshold requirement in mind, Applicant submits that the PTO has failed to establish a *prima facie* case of anticipation using *Del Rey*.

Independent Claim 1 should be allowed because *Del Rey* fails to disclose, expressly or inherently, "initiating a service request message by a first client to a first server, the service request message initiated after a **telephony call** session has been established between the first client and a communication network, the service request message including the first client

identity and a requested service available from a second server comprising a plurality of services."

The Office Action has previously alleged that *Del Rey* discloses these features at Paragraphs 0019, 0020, and 0026, but this is incorrect. Paragraphs 0019, 0020, 0026, generally describe an ability to "enable[] clients and/or advisors the ability to view comprehensive financial data associated with a particular client." In these paragraphs, there is absolutely no discussion of a **telephony call** session. Further, there is absolutely no reference to **telephony call** sessions anywhere within *Del Rey*. Rather, *Del Rey* includes a general discussion of standard internet connections (e.g., SSL connections).

In addition to *Del Rey's* lack of disclosure of telephony call sessions, *Del Rey* provides no details as to how a service request message (containing the first client identity and a requested service) could be initiated after the **telephony call** session has been established..

Additionally, it is unclear from what could features in *Del Rey* could serve as the first server and the second server of Independent Claim 1.

In response to arguments similar to those above, the PTO alleged that an SSL connection is a "telephony call session." *See* Office Action, Page 2 and Advisory Action, Page 2. This, however, is incorrect. Description of an Secure Socket Layer (SSL) connection in and of itself does not disclose a "telephony call session."

In response to arguments similar to those above, the PTO also alleged that "advisor machines" are a "plurality of servers." *See* Final Office Action, Page 2 and Advisory Action, Page 2. Applicants note that *Del Rey* mention nothing of an "advisor machine." Additionally, the PTO does not explain how such alleged "advisor machines" could meet the limitation of the claims, concerning a first server and a second server. To this end, Applicants respectfully remind the PTO that "the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, **must be clearly explained** and each rejected claim specified." 37 C.F.R. §1.104 (Emphasis added). If the PTO alleges the "advisor *desktop*" is a "server," Applicants question how this "desktop" could meet the limitation of the second server, namely " the service request message including the first client identity and a requested service available from a second server comprising a plurality of services."

Independent Claim 1 is also allowable because *Del Rey* fails to disclose, expressly or inherently, "delivering the requested service to the first client during the established telephony call session by the second server in response to determining that the first client is

authorized to use the requested service." The Office Action alleges that paragraph [0031] of *Del Rey* discloses these features, but this is incorrect. Paragraph [0031] of *Del Rey* describes providing a client with a consolidated view of the client's financial portfolio. Paragraph [0031] mentions nothing of "delivering the requested service to the first client during the **established telephony call session** by the **second server** in response to determining that the first client is authorized to use the requested service." More particularly, paragraph [0031] mentions nothing of an **established telephony call session**. Further, if it is maintained that paragraph [0031] teaches the features involving the second server, Applicants question where *Del Rey* discloses features of the "first server" – elsewhere in Claim 1.
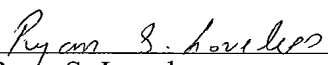
For at least the above reasons, Applicants submit that a *prima facie* rejection has not been established. *Del Rey* does not disclose the claimed invention in as **complete detail** as is contained in Independent Claim 1. Accordingly, Independent Claim 1 and its dependents should be allowed as should Independent Claims 14, 29, and 36 and their dependents for analogous reasons.

CONCLUSION

As a *prima facie* rejection has not been established against Applicants' currently rejected claims, Applicants respectfully request a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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Dated: March 13, 2007

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